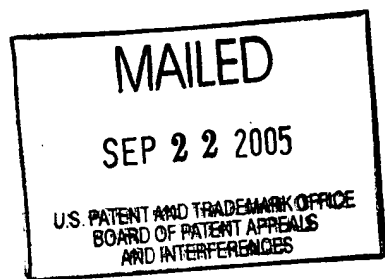


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**



Ex parte TOSHIO YAMAGIWA

Appeal No. 2005-2521
Application No. 09/926,485

ON BRIEF

Before WARREN, OWENS and JEFFREY T. SMITH, Administrative Patent Judges.
JEFFREY T. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claim 1 the sole pending claim. We have jurisdiction under 35 U.S.C. § 134.

BACKGROUND

The Appellant's invention relates to a sealant containing tire. The tire comprises an outer liner fastened to an inner surface of a tread of the tire body and an inner liner defining an air chamber inside the inner liner. The outer liner and inner liner together define an annular sealant chamber which is filled with sealant. The inner liner is formed of a material having a 300% modulus of 60kgf/cm² or less. Claim 1, the sole claim on appeal, is reproduced below:

1. A sealant-containing tire comprising a tire body, an outer liner fastened to an inner surface of a tread of the tire body, and an inner liner defining an air chamber inside the inner liner, the outer liner and the inner liner together defining an annular sealant chamber therebetween which is filled with sealant, the sealant chamber and the air chamber being partitioned by said inner liner, wherein the inner liner is formed of a material of a 300% modulus of 60kgf/cm² or less.

CITED PRIOR ART

As evidence of unpatentability, the Examiner relies on the following references:

Reinowski et al. (Reinowski)	3,042,098	Jul. 03, 1962
Chien	3,563,294	Feb. 16, 1971
Chemizard et al (Chemizard)	4,286,643	Sep. 01, 1981
Biazu (Japanese Patent Application)	JP7-266454	Oct. 17, 1995

The Examiner rejected claim 1 under 35 U.S.C. §103(a) as obvious over Chemizard and Beers and optionally Chien or Reinowski. (Answer, pp. 4-5).

We have carefully reviewed the claim, specification and applied prior art, including all of the arguments advanced by both the Examiner and Appellant in support of their respective positions. This review leads us to conclude that the Examiner's rejection under 35 U.S.C. 103(a) is not well founded.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellant regarding the above-noted rejection, we make reference to Appellant's Brief¹ filed January 4, 2005, Reply Brief filed April 7, 2005 and the Examiner's Answer mailed February 11, 2005.

OPINION

To hold an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the reference teachings and combine them in a way that would produce the claimed invention. See, e.g., *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) (When the patent invention is made by combining known components to achieve a new system, the prior art must provide a suggestion, or motivation to make such a combination.); *Northern Telecom v. Datapoint Corp.*, 908 F.2d 931, 934, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990) (It is insufficient to establish a

¹ Appellant's Brief consists of 8 unnumbered pages not including a cover transmittal letter. We will reference the Brief as though numbered beginning with the first page entitled "Brief on Appeal" as page one.

prima facie case of obviousness based on prior art references disclosing the components of a patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor.); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1044, 1051, 5 USPQ 1434, 1438 (Fed. Cir. 1988).

The Examiner has relied on the combination of Chemizard and Beers and optionally Chien or Reinowski to reject the appealed claim. The Examiner found that Chemizard teaches a sealant containing an inner and outer liners which together define an annular sealant chamber. The Examiner asserts that the inner liner is fastened to the outer liner by the vulcanization process during the tire formation. The Examiner recognized that Chemizard is silent as to the 300% modulus of the inner liner. However, the Examiner concluded that it would have been obvious to form the inner liner having a material with a 300% modulus of 60kgf/cm² or less because compositions with these properties are "extensively used in the tire industry and provide the benefits of good durability and resistance to cracking." (Answer, p. 4). The Examiner relies on the Beers reference to show liners with this property. (Answer, p. 5). The Examiner cited the Reinowski and Chien references as evidence of the desirability of an elastic material for the inner liner of a sealant tire construction. (Answer, p. 5).

Appellant, Brief page 6, asserts that Chemizard does not disclose that the inner liner is formed of a material having a 300% modulus of 60kgf/cm² or less. Appellant further asserts that "Beers merely teaches a liner that is adhered to or integral with the

inside surface of a tire and does not relate to a (inner) liner that cooperates with an outer side liner fastened to a tire tread surface for defining an annular sealant chamber between the two liners. In particular, Beers fails to teach or suggest an outer liner fastened to an inner surface of a tread of a tire body and also fails to teach or suggest an outer liner fastened to an inner surface of a tread of a tire body. . ." (Brief, p. 6).

On the basis of the disclosures of the Chemizard, Beers, Chien and Reinowski references, we are of the opinion that the Examiner has not established a *prima facie* case of obviousness. As correctly stated by Appellant, Chemizard does not disclose the 300% modulus of the inner liner and Beers fails to teach or suggest that the inner liner is suitable for, in cooperation with the outer layer, forming a sealant chamber. Neither, Chien or Reinowski establish that the inner liner of Beers is suitable for forming a sealant chamber as required by the claimed invention. Consequently, the Examiner has not established that an inner liner material described by Beers, having a material with a 300% modulus of 60kgf/cm² or less, is suitable for forming a sealant chamber as required by the claimed invention.

REVERSED

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ARENT FOX PLLC
1050 CONNECTICUT AVENUE, N.W.
SUITE 400
WASHINGTON, DC 20036